

## II. Rejections Under 35 USC § 102

### A. Arraudeau et al.

Claims 1, 4-7, 15-18, 20, 23, 24 and 26-32 stand rejected under 35 USC § 102(b) as being anticipated by Arraudeau et al., U.S. Patent No. 4,659,562. Applicant continues to respectfully traverse this rejection for the reasons of record and those that follow.

Independent claims 1, 29 and 30 each recite that the fibers are compatibilized with a fatty phase by at least one polyol." Independent claim 31 relates to, *inter alia*, a method of improving the staying power of a make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature, the method comprising compatibilizing fibers in the composition. The Examiner's position is that Arraudeau teaches Applicant's compatibilized fibers. Applicant disagrees.

Arraudeau discloses a fatty body comprising "at least one oil or a mixture of at least one oil and at least one wax" (column 2, lines 50-51). Arraudeau lists numerous examples of oils, without disclosing, either expressly or inherently, the combination of a fatty phase, at least one polyol and compatibilized fibers, as recited in Applicant's claims.

In *In re Petering*, the CCPA held that a prior art publication's generic description, although disclosing the Applicant's claimed composition, encompassed an infinite number of possibilities and thus failed to describe the Applicant's invention within the meaning of 35 U.S.C. § 102(b). *In re Petering*, 301 F.2d 676, 681 (CCPA 1962) ("The generic formula of Karrer... encompasses a vast number and perhaps even an infinite number of compounds... Even though appellants' claimed compounds are encompassed by this broad generic disclosure, we do not think this disclosure by itself describes appellants' invention). The CCPA, however, also noted that the prior art publication further disclosed a limited number of preferred compounds that encompassed the applicants' invention. Thus, it was only this limited disclosure of preferred compounds that led the CCPA to find that the claims were anticipated, as the skilled artisan could "at once envisage each member of this limited class." *Id.* <sup>polyol?</sup>

Here, Arraudeau discloses a composition that comprises at least one oil and provides a list of numerous oils for their selection. Arraudeau thus describes an almost infinite number of possibilities of "at least one oil" as this disclosure encompasses compositions containing not only one type of oil, but combinations of two or more types of oils. Unlike the prior art disclosure in *Petering*, Arraudeau does not provide a more limited class of oils that encompasses Applicant's

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claimed combination of a fatty phase and at least one polyol and compatibilizing fibers. Due to the vast number of possibilities described in Arraudeau, those of ordinary skill in the art could not "at once envisage" each element of Arraudeau's composition in order to arrive at Applicant's claims. Thus, Arraudeau's generic disclosure in itself fails to describe Applicant's invention within the meaning of 35 U.S.C. § 102(b).

Applicant also submits that anticipation by a printed publication requires that the publication disclose each and every limitation in a manner allowing those of ordinary skill in the art to "practice the invention without undue experimentation." *Advanced Display Systems v. Kent State University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

Arraudeau similarly does not meet this requirement. Those of ordinary skill in the art would have to carry out undue experimentation on Arraudeau's list of oils to first achieve the element of at least two types of oils, and then achieve the Applicant's specified combination of a fatty phase and at least one polyol. Arraudeau provides no disclosure that the use of two types of oils is preferred, much less that the combination of a fatty phase and at least one polyol is preferred, thus requiring undue experimentation to arrive at the recited combination. Thus, Arraudeau does not describe Applicant's invention within the meaning of 35 U.S.C. § 102(b).

Accordingly, Applicant maintains that Arraudeau et al. fails to disclose any one of: an anhydrous care or make-up composition comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 1); a lipstick or a lip gloss etc., comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 29); a cosmetic care or treatment process for human keratin substances comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 30); or a method for improving the staying power over time and/or a method for improving the gloss of an anhydrous care or make-up composition comprising compatibilizing fibers in the anhydrous care or make-up composition (recited in claim 31).

For at least these independent reasons, Applicant submits that none of the pending claims are anticipated by Arraudeau et al. Accordingly, Applicant respectfully requests withdrawal of this rejection.

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B. Franzke et al.

Claims 1, 4-7, 14-18, 20, 23, 24 and 26-28 stand rejected under 35 USC § 102(e) as being anticipated by Franzke et al., U.S. Patent No. 5,965,146. Applicant continues to respectfully traverse this rejection for the reasons of record and those that follow.

In an argument similar to that discussed above, those of ordinary skill in the art would readily recognize that Franzke fails to disclose sufficient detail to provide a homogenous continuous fatty phase. The vast number of ingredients and ranges disclosed in Franzke provides an almost infinite number of possibilities, such that the skilled artisan would not immediately envisage each element of the compositions Franzke discloses to arrive at Applicant's claims, as set forth in *In re Petering*, discussed above. *In re Petering*, 301 F.2d 676, 681 (CCPA 1962). Furthermore, Franzke fails to provide a limited class of preferred compounds that encompass Applicant's claimed combination of elements within the meaning of 35 U.S.C. 102(b) and that even begin to focus one skilled in the art on Applicant's invention. *Id.*

Applicant previously noted and continues to note that Franzke's examples disclose aqueous or ethanol-based compositions, but not a homogenous continuous fatty phase. In response, the Examiner stated "Franzke can not be limited to his best mode as described in the examples." Applicant's statement, however, is not limited to Franzke's alleged best mode. Indeed, the first sentence of the abstract of Franzke describes the invention as an "aqueous or aqueous/alcoholic cosmetic composition." The numerous examples (25 in all) each exemplify a composition based on an aqueous phase, an aqueous/alcoholic phase, or other non-fatty phases. Applicant's arguments are hardly limiting Franzke to a best mode, but rather to the invention disclosed therein.

Applicant submits that Franzke's disclosure in its 25 examples and the abstract is akin to a limited class of preferred compositions. Finding a list of preferred compositions is the line of inquiry carried out by the CCPA in *Petering*. The *Petering* court did not find anticipation by the broad generic disclosure, but rather by the limited disclosure of preferred compounds. Here, Franzke's limited class of preferred compositions, as discussed in 25 examples and in the abstract, provide aqueous or aqueous/alcoholic cosmetic compositions having a water content of 6.5-96 %, placing all of Franzke's exemplary compositions outside the scope of Applicant's anhydrous compositions. Thus, Franzke's aqueous and aqueous/alcoholic compositions teach

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the skilled artisan away from the preparation of an anhydrous composition. The Examiner has failed to point to any contradictory teachings in Franzke.

Thus, Franzke fails to disclose a composition comprising an anhydrous composition comprising a homogeneous fatty phase, as recited in Applicant's claims 1-28.

For at least these reasons, none of the rejected claims are anticipated by Franzke. Accordingly, Applicant respectfully requests withdrawal of this rejection.

### **III. Rejection under 35 USC § 103**

Claims 2, 3, 14-22 and 25-32 stand rejected under 35 USC § 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al. (U.S. Patent No. 6,177,091) and Arnaud (FR 278393 A1, Abstract). Applicant continues to respectfully traverse this rejection.

In the previous response, Applicant noted that the Abstract of Arnaud was published on June 2, 2000, which does not antedate either the French priority document of the present application (filed May 20, 1999) or the U.S. filing date of the present application (May 22, 2000). As Arnaud fails to meet any of the requirements of a proper reference based on 35 U.S.C. § 102, Arnaud is not applicable as a reference under 35 U.S.C. § 103 and should be disqualified from this rejection.

The Examiner failed to comment on the inapplicability of the Arnaud reference and continued to maintain this rejection in view of Arnaud. If the Examiner continues to rely on Arnaud, Applicant respectfully requests that the Examiner cite authority explaining why Arnaud is applicable prior art in response to Applicant's arguments provided above.

Applicant continues to maintain that those of ordinary skill in the art having knowledge of Arraudeau et al.'s composition comprising fibers would not find it obvious to substitute Arraudeau's composition base with the base of the composition of Bara et al. and to compatibilize Arraudeau's fibers in the Bara base, due to a lack of clear teaching or suggestion in the references, as set forth by Applicant's remarks in the previous Amendment. Thus, the Examiner has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this rejection.

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**IV. Conclusion**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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